

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

QUALCOMM INCORPORATED
Petitioner

v.

NETWORK SYSTEM TECHNOLOGIES, LLC
Patent Owner

Patent No. 7,373,449

Inter Partes Review No. IPR2024-01081

PATENT OWNER'S PRELIMINARY SUR-REPLY

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Patent Owner submits this preliminary sur-reply pursuant to authorization from the Board on August 2, 2024. EX3002.

Qualcomm does not dispute that it is taking inconsistent positions on the construction of term “communication manager.” POPR, 22-24; Reply, 1-2. Qualcomm's rationales for its irreconcilable positions fail.

Qualcomm first argues that “PO is not even arguing that the term [communication manager] needs construction in this IPR.” Reply, 1. This is a red herring. Whether Patent Owner proposed a construction has no bearing on whether Qualcomm is taking inconsistent positions. Indeed, it was Qualcomm's duty to identify its claim constructions in the Petition. 37 C.F.R. § 42.104(b)(3); *Orthopediatrics Corp., v. K2M, Inc.*, IPR2018-01546, Paper 10 at 11 (PTAB Feb. 14, 2019) (finding that “it is incumbent upon Petitioner to address” a construction that “is likely to be a focal point of the ... proceeding”). The Board's rules also require Qualcomm to “identify the specific portions of the specification that describe the structure, materials, or acts corresponding to each claim function” for means-plus-function terms. 37 C.F.R. § 42.104(b)(3). Qualcomm also failed to do that.

Second, Qualcomm doubles down on its claim that it does not disagree with the Samsung IPR constructions. Reply, 1. But by virtue of proposing a § 112, ¶ 6 construction in district court, Qualcomm necessarily disagrees with Samsung's plain and ordinary meaning construction. *See Facebook, Inc. v. Sound View Innovations*,

LLC, IPR2017-00998, Paper 13 at 16 (PTAB Sept. 5, 2017) (noting that a “claim either contains means-plus function terms or it doesn’t”). In fact, Qualcomm has expressly argued in district court that the construction is wrong. EX2044, 5-9. The Board should not credit Qualcomm’s gamesmanship.

Third, Qualcomm argues that “there is nothing improper about Petitioner maintaining its argument before the district court that a claim term is indefinite.” Reply, 1. The cases Qualcomm cites in support of this argument are inapposite. First, the petitioners in those cases acquiesced to the patent owner’s district court constructions. *Dish Network LLC v. Digital Broadcasting Sols., LLC*, IPR2023-00976, Paper 8 at 7-9 (PTAB Dec. 11, 2023); *Hospira Inc. v. Amgen Inc.*, IPR2021-00528, Paper 7 at 6-10 (PTAB Aug. 17, 2021); *Sony Elecs. Inc. v. Jawbone Innovations, LLC*, IPR2023-01352, Paper 9 at 47-48 (PTAB Mar. 7, 2024). By contrast, Qualcomm is agreeing to “the constructions applied in the Samsung IPR” here, while simultaneously disagreeing with them in district court. Reply, 2. Second, **none** of Qualcomm’s cited cases involved § 112, ¶ 6 indefiniteness. If there is no corresponding structure for the “communication manager,” as Qualcomm contends in the district court litigation, then institution should be denied. *Samsung Elecs. Am., Inc. v. Prisia Eng'g Corp.*, 948 F.3d 1342, 1353 (Fed. Cir. 2020) (“the proper course for the Board to follow, if it cannot ascertain the scope of a claim with reasonable certainty for purposes of assessing patentability, is to decline to institute the IPR”).

Qualcomm's attempts to distinguish *Hologic* and *CareFusion* fail. Like those petitioners, Qualcomm clearly disagrees with the constructions it seeks to apply in this IPR. *Hologic, Inc. v. Enzo Life Sciences, Inc.*, IPR2018-00019, Paper 21 at 8-9 (PTAB Nov. 28, 2018); *CareFusion Corp. v. Baxter Int'l, Inc.*, IPR2016-01456, Paper 9 at 7 (PTAB Feb. 6, 2017); *see also Hologic*, IPR2018-00019, Paper 3 at 8, 11, 15 ("Although Petitioner disagrees with Patent Owner's infringement position the analyses ... are based on Patent Owner's interpretation of the [term]"); Petition, 35, n.6. Qualcomm's reliance on cases purportedly distinguishing *Hologic* and *CareFusion* is inapposite because Qualcomm has expressly disagreed with the constructions in this IPR. Reply, 3; *supra*; *Western Digital Corp. v. SPEX Tech. Inc.*, IPR2018-00084, Paper 14 (PTAB Apr. 25, 2018) (distinguishing *CareFusion* because Petitioner did not expressly disagree with any offered constructions); *Allen Med. Sys. Inc. et al. v. Mizuho Orthopedic Sys, Inc.*, IPR2022-00919, Paper 12 at 15-18 (PTAB Nov. 2, 2022) (distinguishing *Hologic* and *CareFusion* because Petitioner did not expressly disagree with any offered constructions).

For at least the foregoing reasons and the reasons set forth in the Preliminary Response, the Petition should be denied as to each of the requested grounds.

U.S. Patent No. 7,373,449
IPR2024-01081

Patent Owner's Preliminary Sur-Reply

Respectfully submitted,

Dated: August 9, 2024

By: /Jennifer Hayes/
Jennifer Hayes
Reg. No. 50,845
Nixon Peabody LLP
300 South Grand Avenue,
Suite 4100,
Los Angeles, CA 90071-3151
Tel. 213-629-6179
Fax 866-781-9391

Lead Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **Patent Owner's Preliminary Sur-Reply** was served on August 9, 2024, by email:

J. Derek Vandenburg
Aaron W. Pederson
Nathan D. Louwagie
Ryan D. Rypka
CARLSON CASPERS VANDENBURGH & LINDQUIST, P.A.
225 South Sixth Street, Suite 4200
Minneapolis, MN 55402
Telephone: (612) 436-9618
dvandenburg@carlsoncaspers.com
apederson@carlsoncaspers.com
nlouwagie@carlsoncaspers.com
rrypka@carlsoncaspers.com

Counsel for Petitioner, Qualcomm Incorporated

By: /s/ Jennifer Hayes

Lead Counsel for Patent Owner